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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/619,066      | 07/14/2003  | Jay S. Walker        | 03-041              | 5879             |

22927 7590 08/23/2005

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EXAMINER

NGUYEN, KIM T

ART UNIT PAPER NUMBER

3713

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/619,066

Applicant(s)

WALKER ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/14/03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 2-4, 7, 10 and 23 are objected to because of the following informalities:
  - a) In claim 2, line 14; claim 2, line 7; claim 4, line 11; claim 10, line 12; and claim 23, line 12, the claimed limitation "at least the final set of cards" should be corrected to "the final set of cards".
  - b) In claim 7, line 2, the claimed limitation "at least one secondary set" should be corrected to "secondary set".

Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,592,456. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-24 disclose the same subject matter as taught in claims 1-31 of patent 6,592,456 in broader scope by eliminating the limitations clear the display of the first final primary poker hand and preserve the secondary poker hand, receive a second wager for a second play of the poker game, etc. Further, determining a second payout based on the secondary poker hand would have been old and well known in the art.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moody (US patent No. 5,732,950).**

As per claim 1, Moody discloses a method comprising receiving a first wager for a first play of a poker game (col. 3, lines 66-67); displaying a first primary poker hand (col. 4, lines 10-11); receiving a selection of at least one discard card to be discarded from the first primary poker hand (col. 4, lines 34-38); populating a secondary poker hand with the at least one discard card (col. 4, lines 52-54); populating the first primary poker hand to replace the at least one discard card discarded therefrom, thereby forming a first final primary poker hand (col. 4, lines 39-41); determining a first payout based at least upon the first wager and the playing cards in the first final primary poker hand (col. 5, lines 15-18). Moody does not explicitly disclose determining a second payout based on the secondary poker hand. However, in another embodiment, Moody suggests determining payout for each poker hand (col. 6, lines 41-44). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine payout based on the secondary poker hand as suggested by Moody in order to allow the player to play multiple poker hands.

***Allowable Subject Matter***


5. Claims 2-24 would be allowable if a terminal disclaimer in compliance with 37 CFR 1.321(c) is filed to overcome the double patenting rejection(s), set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to show or fairly suggests an apparatus and a method as set forth in independent claims 2-4, 10 and 23 in including but not limited to at least “populating the primary set of card positions with a second set of initial cards”, and “populating at least one secondary set of card positions with at least the at least one discarded card from the first set of initial cards and the at least one discarded card from the second set of initial cards” in claims 2-3; “selecting a card position of a primary set of card positions”, and “if the discarded card is associated with the selected card position, populating a secondary set of card positions with the discarded card” in claim 4; “determining whether to include the at least one discarded card in at least one secondary set of card positions; if the at least one discarded card is to be included in the at least one secondary set of card positions, populating the at least one secondary set of card positions with the at least one discarded card” in claim 10; and “determining whether to include the at least one held card in at least one secondary set of card positions; if the at least one held card is to be included in the at least one secondary set of card positions, populating the at least one secondary set of card positions with the at least one held card” in claim 23.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 703-872-9306.

kn  
Date: August 18, 2005



Kim Nguyen  
Primary Examiner  
Art Unit 3713